

ESTTA Tracking number: **ESTTA571733**Filing date: **11/19/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Mycoskie, LLC		
Entity	Corporation	Citizenship	California
Address	5404 Jandy Place Los Angeles, CA 90066 UNITED STATES		

Attorney information	Louis S. Ederer and Laura W. Tejeda Arnold & Porter LLP 555 Twelfth Street, NW Washington, DC 20004 UNITED STATES trademarkdocketing@aporter.com, louis.ederer@aporter.com, laura.tejeda@aporter.com, elisabeth.richards@aporter.com, matthew.salzmann@aporter.com Phone:2029425000
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Applicant Information

Application No	85445878	Publication date	10/22/2013
Opposition Filing Date	11/19/2013	Opposition Period Ends	11/21/2013
Applicant	Pape, Bryan J. P.O. Box 3663 Bellevue, WA 98009 USX		

Goods/Services Affected by Opposition


Class 039. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Charitable services, namely, donating abicycle to those in need


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	4400105	Application Date	02/08/2013
Registration Date	09/10/2013	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2010/04/15 First Use In Commerce: 2010/04/15 Charitable services, namely, providing safe drinking water to those in developing countries


U.S. Registration No.	4307523	Application Date	10/13/2011
Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2008/05/01 First Use In Commerce: 2008/05/01 Charitable fundraising services Class 044. First use: First Use: 2011/07/01 First Use In Commerce: 2011/07/01 Charitable services, namely, providing medical attention, ophthalmology and optometry services to those in need; and Charitable services, namely, providing eyewear to those in need Class 045. First use: First Use: 2008/12/31 First Use In Commerce: 2008/12/31 Charitable services, namely, providing shoes to those in need		

U.S. Registration No.	4170419	Application Date	06/16/2011
Registration Date	07/10/2012	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2011/06/08 First Use In Commerce: 2011/06/08 Sunglasses and cases for sunglasses


U.S. Registration No.	4204485	Application Date	06/06/2011
Registration Date	09/11/2012	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2008/05/01 First Use In Commerce: 2008/05/01 Clothing, namely, hats, sweatshirts, hooded sweatshirts, t-shirts and shoes		


U.S. Registration No.	4208986	Application Date	10/13/2011
Registration Date	09/18/2012	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/05/15 First Use In Commerce: 2006/05/15 Retail store services and on-line retail store services in the field of footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters


U.S. Application No.	86004049	Application Date	07/08/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 Goods made of leather or imitations of leather; bags; trunks; valises; suitcases; tote bags; travelling bags; garment bags; rucksacks; satchels; holdalls; handbags; shoulder bags; shopping bags; wheeled shopping bags and purses; pouches; wallets; credit card holders of leather and imitations of leather; pouches; luggage labels and tags; collars; and leashes for animals		

U.S. Application No.	85965243	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE FOR ONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 0 First Use In Commerce: 0 Coffee, tea, cocoa, and coffee-based beverages; and artificial coffee

U.S. Registration No.	4403201	Application Date	02/08/2013
Registration Date	09/17/2013	Foreign Priority Date	NONE
Word Mark	TOMS ONE FOR ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2010/04/15 First Use In Commerce: 2010/04/15 Charitable services, namely, providing safe drinking water to those in developing countries		

U.S. Application No.	85844897	Application Date	02/08/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOMS ONE FOR ONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 0 First Use In Commerce: 0 Drinking water

Attachments	85845010#TMSN.jpeg(bytes) 85447270#TMSN.jpeg(bytes) 85348161#TMSN.jpeg(bytes) 85339106#TMSN.jpeg(bytes) 85447150#TMSN.jpeg(bytes) 86004049#TMSN.jpeg(bytes) 85965243#TMSN.jpeg(bytes) 85845015#TMSN.jpeg(bytes) 85844897#TMSN.jpeg(bytes) Notice of Opposition for ONE4ONE.pdf(65812 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Louis S. Ederer/
Name	Louis S. Ederer
Date	11/19/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Ser. No. 85/445,878

Mark: ONE4ONE

Filed: October 12, 2011

Published in the Official Gazette: October 22, 2013

Mycoskie, LLC,)	
)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
Bryan J. Pape,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Mycoskie, LLC (“Opposer”) believes that it will be damaged by registration of the mark ONE4ONE (“Applicant’s ONE4ONE Mark”), which is the subject of Application Ser. No. 85/445,878, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063 and Trademark Rule 2.101.

The grounds of Opposition are as follows:

1. Opposer, Mycoskie, LLC, is a corporation duly organized and existing under the laws of the California, having its principal place of business at 5404 Jandy Place, Los Angeles, California 90066.

2. On information and belief, Applicant, Bryan J. Pape, is an individual whose mailing address is P.O. Box 3663, Bellevue, Washington 98107.

3. Opposer is the proprietor of the well-known TOMS brand of footwear, eyewear, apparel, and other products and services. The TOMS brand is also widely recognized for its promotional programs involving the charitable donation of products and services through Opposer's highly publicized "One For One" campaign. Since May 2008, Opposer has continuously used its ONE FOR ONE mark in connection with charitable-related services and goods that directly tie in to the basic premise of TOMS "One For One" campaign — namely, for every TOMS product that is sold, Opposer makes a donation of a product or service to a person in need.

4. Opposer owns several federal trademark registrations and/or pending applications for the mark ONE FOR ONE, including the following ("Opposer's ONE FOR ONE Marks"):

Mark	Reg. No. / Serial No.	Class	Goods/Services
ONE FOR ONE	4,400,105	43	Charitable services, namely, providing safe drinking water to those in developing countries
ONE FOR ONE	4,307,523	36	Charitable fundraising services
		44	Charitable services, namely, providing medical attention, ophthalmology and optometry services to those in need; and Charitable services, namely, providing eyewear to those in need
		45	Charitable services, namely, providing shoes to those in need
ONE FOR ONE	4,170,419	9	Sunglasses and cases for sunglasses
ONE FOR ONE	4,204,485	25	Clothing, namely, hats, sweatshirts, hooded sweatshirts, t-shirts and shoes
ONE FOR ONE	4,208,986	35	Retail store services and on-line retail store services in the field of footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters
ONE FOR ONE	86/004,049	18	Goods made of leather or imitations of leather; bags; trunks; valises; suitcases; tote bags; travelling bags; garment bags; rucksacks; satchels; holdalls; handbags; shoulder bags; shopping bags; wheeled shopping bags and purses; pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage labels and tags; collars; and leashes for animals
ONE FOR ONE	85/965,243	30	Coffee, tea, cocoa, and coffee-based beverages; tea products and coffee products; and artificial coffee

Mark	Reg. No. / Serial No.	Class	Goods/Services
TOMS ONE FOR ONE	4,403,201	43	Charitable services, namely, providing safe drinking water to those in developing countries
TOMS ONE FOR ONE	85,844,897	32	Drinking water

5. As evidenced in Opposer's registration of its ONE FOR ONE Mark in International Class 36 (charitable fundraising services), Opposer has been using the mark ONE FOR ONE in connection with its widely recognized charitable giving programs since as early as May 1, 2008. Moreover, in direct association with its ONE FOR ONE charitable giving programs, Opposer, through its exclusive licensee, has provided products and services to those in need under its ONE FOR ONE Marks since as early as December 2008.

6. Opposer has made substantial investments in advertising, promoting, marketing and developing public awareness for Opposer's charitable services and sale of related goods and services under and provided in connection with Opposer's ONE FOR ONE Marks, and Opposer has established substantial goodwill in its ONE FOR ONE Marks. Indeed, Opposer was the first to institute such charitable giving programs under the mark ONE FOR ONE, and has received substantial publicity, and has been widely recognized for such programs. Accordingly, Opposer's ONE FOR ONE Marks and the charitable giving programs associated therewith have become so well-known that consumers immediately recognize Opposer's ONE FOR ONE Marks, and associate such marks with Opposer and/or the charitable products and services offered by Opposer.

7. On information and belief, on October 12, 2011, Applicant filed an application on an intent-to-use basis to register Applicant's ONE4ONE Mark. The application is the subject of Application Ser. No. 85/445,878 for "Charitable services, namely, donating a bicycle to those in need" in International Class 39.

8. Applicant's ONE4ONE Mark was published for opposition on October 22, 2013.

9. Applicant, individually and through his wholly owned company, MiiR Inc., has two additional ONE4ONE applications pending before the U.S. Trademark Office, both of which are the subject of opposition proceedings commenced by Opposer: Application Ser. No. 85/446,003 in International Class 12 (bicycles) (Opposition No. 91207974); and Application Ser. No. 85/258,577, in International Class 21 (reusable bottles sold empty) (Opposition No. 91204474).

10. On information and belief, to date Applicant has not made use of his ONE4ONE Mark as shown in Application Ser. No. 85/445,878 in connection with charitable services of any kind.

11. Applicant's ONE4ONE Mark is confusingly similar in meaning and appearance to Opposer's ONE FOR ONE Marks, and is phonetically identical to Opposer's ONE FOR ONE Marks.

12. The services identified in Application Ser. No. 85/445,878 — *i.e.*, "Charitable services, namely, donating a bicycle to those in need" — are identical and/or closely related to the charitable services offered by Opposer under its ONE FOR ONE Marks, namely, providing charitable services (International Class 36), and in particular, for every product sold by Opposer, providing an essential product or service to those in need.

13. On information and belief, Applicant will market his services under Applicant's ONE4ONE Mark to the same types of consumers to which Opposer's services and goods are offered, or are to be offered, under and in connection with the Opposer's ONE FOR ONE Marks.

14. Applicant's use and registration of his ONE4ONE Mark for charitable services in International Class 39 will allow Applicant to unjustly trade on the goodwill established, at great

cost, by Opposer in its ONE FOR ONE Marks, to the direct detriment of Opposer and its business activities.

15. Applicant's ONE4ONE Mark so resembles Opposer's ONE FOR ONE Marks as to be likely, when used in association with Applicant's contemplated services, to cause confusion or mistake or to deceive the relevant consuming public as the source of such services, causing damage to Opposer in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

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For the reasons set forth above, Opposer believes that it will be damaged by the registration of Applicant's ONE4ONE Mark as shown in Application Ser. No. 85/445,878. Applicant should thus be denied registration of this proposed mark, and this Opposition to Application Serial No. 85/445,878 should be sustained.

The required filing fee was paid online in the ESSTA filing. Please direct all correspondence to Louis S. Ederer, Arnold & Porter, LLP, 399 Park Avenue, New York, New York 10022.

Dated: November 19, 2013

Respectfully submitted,

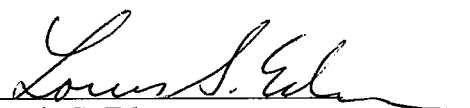
By: 
Louis S. Ederer, Esq.
ARNOLD & PORTER LLP
399 Park Avenue
New York, New York 10022
(212) 715-1000

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **NOTICE OF OPPOSITION** was served on counsel for Applicant as identified by the records of the U.S. Patent and Trademark Office, this 19th day of November, 2013, by sending same via First Class mail, postage prepaid, to:

John Janeway, Esq.
Janeway Patent Law PLLC
2208 NW Market Street, Ste 508
Seattle, WA 98107-4098



Louis S. Ederer